REMARKS

This paper is responsive to the Office Action dated February 2, 2007. All rejections and objections of the Examiner are respectfully traversed. Reconsideration and further examination are respectfully requested.

At paragraph 2 of the Office Action, the Examiner objected to the drawings as originally filed. Amendments to the Specification and Fig. 23 herein are respectfully believed to meet all requirements of the Examiner in this regard.

At paragraph 3 of the Office Action, the Examiner rejected claim 32 as being directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

Applicants first respectfully note that the PTO has for years accepted claims directed to program code embodied in a carrier wave. This type of claim format is the direct outcome of published training materials used in the PTO that expressly included an example of an acceptable claim to a "computer data signal embodied in a carrier wave". In fact, the PTO has issued many patents having at least one such "propagated signal" claim ("hundreds" of such patents have been issued, according to "RESPONSE TO THE PTO REQUEST FOR COMMENTS ON PROPOSED GUIDELINES RE:SUBJECT MATTER ELIGIBILITY", submitted to the PTO by The National Association of Patent Practitioners, July 31, 2006). In reliance on these well known facts, Applicants have in this case applied for claim 32 to protect the invention in what has become a standard claim format used for computer related inventions. Applicants respectfully submit that for the Patent Office to now to promote rejection of such claims, based on interpretation of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility published on 22 November 2005 ("Interim Guidelines"), is an unfair reversal of a well established policy, based solely on administrative actions internal to the Patent

Office, without sufficient motivation or support in statutory or case law. No new case has been decided, or law enacted, that provides a reasonable basis for such a change in treatment of this type of claim.

Applicants respectfully assert that 35 U.S.C. 101 still does not preclude signal-related claims such as the present claim 32. 35 U.S.C. 101 states as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The present claim 32 should at least be considered proper subject matter as a "manufacture" under 35 U.S.C. 101. Applicants respectfully disagree with the proposition espoused in the Interim Guidelines that signal claims lack physical substance. The present claim 32 is directed to "A computer data signal embodied in a carrier wave . . . ", and as such would be recognized by those skilled in the art as a *physical* signal, recognizable by a computer system, and used to convey computer program code and/or data through a computer communication network by way of a carrier wave on which it is embodied. Applicants respectfully submit that the subject matter of claim 32 is thus physically substantial, and claim 32 is therefore clearly not directed to something that would be considered physically insubstantial, such as a mere mental process or thought. As is well known in the art, the relevant physical substance of the "computer data signal" in claim 32 is the representation of the computer program it embodies, which in turn is significant to the functional operation of a receiving computer system.

In addition, the category of "manufacture" in 35 U.S.C. 101 includes no requirement that a claim be directed to a "tangible physical article or object", as asserted in the Interim Guidelines. Such a requirement would run contrary to the Supreme Court's well known holding in *Diamond V. Chakrabarty* that the statute is intended to include "anything under the sun that is made by

man". Similarly, the Federal Circuit has held that "physical matter" is not an appropriate test for the determination of patentable subject matter. For example, *In re Lowry* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) found eligible subject matter for an invention in which ". . . the stored data adopt no physical 'structure' per se. Rather, the stored data exist as a collection of bits . . ."

For these reasons Applicants respectfully urge that claim 32 as it currently stands is directed to statutory subject matter under 35 U.S.C. 101.

At paragraphs 4-5 of the Office Action, the Examiner rejected claims 1, 3, 5, 7, 11, 13, 15, 17, 21, 23, 25, 27, 31 and 32 for anticipation under 35 U.S.C. 102, citing United States published patent application 2005/00554505 of Kaminsky et al. ("Kaminsky et al."). At paragraph 8 of the Office Action, the Examiner rejected dependent claims 4, 8, 14, 18, 24 and 28 for obviousness under 35 U.S.C. 103, again citing Kaminsky et al. Applicants respectfully traverse these rejections.

Kaminsky et al. disclose techniques for managing instant messages, including the display of windows for incoming messages, as well as for managing status information for instant messaging users. The teachings of Kaminsky et al. include techniques for an instant messaging user to define policy information to determine a response to an arriving instant message, to control whether a new window will pop up for a newly-arriving message, and to specify other attributes of such a new window. Kaminsky et al. further describe a technique for an instant messaging user to define attributes pertaining to how his or her instant messaging status will be presented to other users.

Kaminsky et al. also disclose that while other instant messaging systems may be limited to three predefined types or levels of user status (e.g. "active", "away", and "do not disturb"), the

Kaminsky et al. system enables instant messaging users to define additional status levels, which can then be made available to other users. The instant messaging user defining additional status levels through the Kaminsky et al. system may specify attributes to be associated with those levels. In this regard, Kaminsky et al. disclose that if green is used when presenting an icon for active instant messaging users as a visual indication that a speedy response may be expected, a user may specify that yellow should be used for his or her icon when he is in a "temporarily distracted" state, thereby efficiently conveying to other users that his messages may be delayed.

Kaminsky et al. further disclose that an instant messaging user's status may be distributed to other clients using messages including the user's current status, display text associated with that status, a color and/or the URL of an icon associated with that status.

Nowhere in Kaminsky et al. is there disclosed or suggested any method or system for providing a local user of an instant messaging system with updated status information regarding at least one remote user, including:

> obtaining, by an awareness client application process executing on a local computer system, from an associated awareness server application process executing on a server computer system, an online status of said remote computer system user;
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> presenting, by said awareness client application process, a representation of said remote computer system user, wherein said representation of said remote computer system user includes an indication of said online status of said remote computer system user;
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> obtaining, by said awareness client application process on said local computer system, an updated status message associated with said remote computer system user; and
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> ***modifying said indication of said online status of said remote computer system user to include an indication that said updated status message associated with said remote computer system user is available, wherein said modifying does not present said updated status message.*** (emphasis added)

as in the present independent claim 1. Independent claims 11, 21, 31 and 32 include analogous features. While Kaminsky et al. describe a system that allows for user defined status levels,

there is no teaching or disclosure by Kaminsky et al. regarding even the possibility of modifying an indication of a user's online status to include an indication that an updated status message is *available*, where that modification *does not include presenting the updated status message* to the user. Instead, Kaminsky et al. describe a system in which the user can specify attributes associated with the status levels, where those attributes *visually indicate the status levels themselves*, for example by changing the color of an icon to indicate a new status level for a remote user. These teachings of Kaminsky et al. stand in contrast to creating an indication of the *availability* of a new status message that does not represent the updated status message itself, which is expressly set forth and advantageous feature of the present independent claims.

For the above reasons, Applicants respectfully submit that Kaminsky et al. does not disclose or suggest all the features of the present independent claims 1, 11, 21, 31 and 32. Accordingly, Kaminsky et al. does not anticipate the present independent claims 1, 11, 21, 31 and 32 under 35 U.S.C. 102, nor does Kaminsky et al. form the basis for a *prima facie* case of obviousness under 35 U.S.C. 103 with regard to independent claims 1, 11, 21, 31 and 32. As to dependent claims 3-5, 7, 8, 13-15, 17, 18, 23-25, 27, and 28, they each depend from claims 1, 11, and 21, and are respectfully believed to be patentable over Kaminsky et al. for at least the same reasons.

In paragraphs 6-7 of the Office Action, the Examiner rejected claims 2, 6, 12, 16, 22 and 26 for obviousness under 35 U.S.C. 103, citing the combination of Kaminsky et al. with United States published patent application number 2004/0183829 of Kontny et al. ("Kontny et al."). Applicants respectfully traverse this rejection.

Kontny et al. disclose a dynamic collaboration assistant application including a collaborative gateway application for generating a collaborative gateway graphical user interface.

Kontny et al. describe a context listener module located on the terminal and used to continuously monitor a context in which a user is using the terminal. A context translator module analyzes the context message and dynamically adjusts the display of the collaboration applications in the collaborative gateway graphical user interface as a function of the context in which the user is using the terminal.

The Web server application in Kontny et al. includes a buddy list component that generates a buddy list for the user based on a current active context. The instant message buddy list of Kontny et al. contains a representative illustration of the output of a meeting facilitation component. When a user hovers over a contact in the instant message buddy list of Kontny et al., a contact graphical user interface may be generated containing contact information, which may incorporate current availability, preferred method of contact, and the ability to instantaneously engage in a collaborative session.

The relevant teachings of Kaminsky et al. are summarized above.

Nowhere in the combination of Kaminsky et al. and Kontny et al. is there disclosed or suggested any method or system for providing a local user of an instant messaging system with updated status information regarding at least one remote user, including:

> obtaining, by an awareness client application process executing on a local computer system, from an associated awareness server application process executing on a server computer system, an online status of said remote computer system user;
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> presenting, by said awareness client application process, a representation of said remote computer system user, wherein said representation of said remote computer system user includes an indication of said online status of said remote computer system user;
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> obtaining, by said awareness client application process on said local computer system, an updated status message associated with said remote computer system user; and
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> ***modifying said indication of said online status of said remote computer system user to include an indication that said updated status message associated with said***

remote computer system user is available, wherein said modifying does not present said updated status message. (emphasis added)

as in the present independent claim 1. Independent claims 11 and 21 include analogous features. As noted above, there is no teaching or disclosure by Kaminsky et al. regarding modifying an indication of a user's online status to include an indication that an updated status message is *available*, where that modification *does not include presenting the updated status message* to the user. The addition of Kontny et al. to Kaminsky et al. provides a display of specific contact information regarding a buddy list member, but the combined references still fail to disclose or suggest creating an indication of the *availability* of a new status message that does not represent the updated status message itself, as in the present independent claims.

For the above reasons, Applicants respectfully submit that the combination of Kaminsky et al. and Kontny et al. does not disclose or suggest all the features of the present independent claims 1, 11 and 21. Accordingly, the combination of Kaminsky et al. and Kontny et al. does form the basis of a *prima facie* case of obviousness under 35 U.S.C. 103 with regard to independent claims 1, 11 and 21. Claims 2, 6, 12, 16, 22 and 26 each depend from claims 1, 11, and 21, and are respectfully believed to be patentable over the combination of Kaminsky et al. and Kontny et al. for at least the same reasons.

In paragraph 9 of the Office Action, the Examiner rejected claims 9, 10, 19, 20, 29 and 30 for obviousness under 35 U.S.C. 103, citing the combination of Kaminsky et al. with United States patent number 6,697,840 of Godefroid et al. ("Godefroid et al."). Applicants respectfully traverse this rejection.

Godefroid et al. disclose presence awareness initiatives implemented in a collaborative system that enables a user to set presence awareness policies, and that provides a reasonably high

assurance that the system will correctly implement those policies. The collaborative presence awareness system of Godefroid et al. enables users to specify presence awareness policies, and includes tools to establish a level of assurance that the presence awareness system has the capability to implement correctly, substantially all possible presence awareness policies. The presence awareness policy specifications of Godefroid et al. are modular relative to the rest of the presence awareness system, and can be modified without having to modify computational modules or user interface program code of the presence awareness system. A user of the Godefroid et al. system can update his or her presence information. In accordance with still another aspect of the invention, the Godefroid et al. system automatically collects presence information about the user and automatically updates his or her presence information. The presence awareness system of Godefroid et al. may use specification-based testing at run-time to monitor whether some users' presence awareness policies have inadvertently been violated, further strengthening the reliability of the system.

Godefroid et al. further disclose that a user interface sends the messages to the rest of a presence awareness system indicating login, logout, screensaver(on), and screensaver(off) events.

In the Godefroid et al. system, a user may inquire about the presence of other users. These inquiries may relate to a user's interest in the login status of another user, the screen saver status of another user, whether another user is in a collaborative session, the other user's indicated willingness to interact (a "door" status), access rules and settings of the other user, and the other user's calendar, location, phone number, email address, and real name (in the case of anonymous participation). For these user activities, the Godefroid et al. user interface sends check-availability (X), check-name(X), check-chatters(X) messages to the rest of the presence awareness system, and receives available(X), unavailable(X), name(real(X), pseudo(Y)), and

chatters(SID, SetOfChatters) messages from the presence awareness system, where each chat session is identified by a globally unique id "SID".

The relevant teachings of Kaminsky et al. are summarized above.

Nowhere in the combination of Kaminsky et al. and Godefroid et al. is there disclosed or suggested any method or system for providing a local user of an instant messaging system with updated status information regarding at least one remote user, including:

> obtaining, by an awareness client application process executing on a local computer system, from an associated awareness server application process executing on a server computer system, an online status of said remote computer system user;
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> presenting, by said awareness client application process, a representation of said remote computer system user, wherein said representation of said remote computer system user includes an indication of said online status of said remote computer system user;
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> obtaining, by said awareness client application process on said local computer system, an updated status message associated with said remote computer system user; and
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> ***modifying said indication of said online status of said remote computer system user to include an indication that said updated status message associated with said remote computer system user is available, wherein said modifying does not present said updated status message.*** (emphasis added)

as in the present independent claim 1. Independent claims 11 and 21 include analogous features. Like Kaminsky et al., Godefroid et al. includes no teaching or disclosure regarding modifying an indication of a user's online status to include an indication that an updated status message is *available*, where that modification *does not include presenting the updated status message* to the user. Accordingly, the combination of Kaminsky et al. and Godefroid et al. fails to disclose or suggest creating an indication of the *availability* of a new status message that does not represent the updated status message itself, as in the present independent claims.

For the above reasons, Applicants respectfully submit that the combination of Kaminsky et al. and Godefroid et al. does not disclose or suggest all the features of the present independent

claims 1, 11 and 21. Accordingly, the combination of Kaminsky et al. and Godefroid et al. does not support a prima facie case of obviousness under 35 U.S.C. 103 with regard to independent claims 1, 11 and 21. As claims 9, 10, 19, 20, 29 and 30 depend from claims 1, 11 and 21 they are respectfully believed to be patentable over the combination of Kaminsky et al. and Godefroid et al. for at least the same reasons.

Reconsideration of all claims is respectfully requested.

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Applicants' Attorney at the number listed below so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

May 1, 2007
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Docket No. 260-010
Dd: 05/2/2007